



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,696	12/20/2001	Missy L. Villapudua	020375-003100US	4166

20350 7590 03/03/2003

TOWNSEND AND TOWNSEND AND CREW, LLP  
TWO EMBARCADERO CENTER  
EIGHTH FLOOR  
SAN FRANCISCO, CA 94111-3834

EXAMINER

WOO, RICHARD SUKYOON

ART UNIT	PAPER NUMBER
----------	--------------

3629

DATE MAILED: 03/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/027,696

Applicant(s)

VILLAPUDUA, MISSY L.

Examiner

Richard Woo

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other: \_\_\_\_

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1) The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

### ***Claim Rejections - 35 USC § 112***

2) The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3) Claims 1-10 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claim 1, line 6, the recitation of "some" renders the claim indefinite because it is not clear how much data should be stored onto the payment instrument (it is not clear how the applicant defines "some" (no range, no limitation)).

In Claim 12, line 2, the recitation of "may" renders the claim indefinite because it is not clear whether the marketing material actually is sent to the consumer or not.

***Claim Rejections - 35 USC § 103***

4) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5) Claims 1-2, 4-14 and 16, as far as Claims 1-2 and 4-10 are definite, are rejected under 35 U.S.C. 103(a) as being unpatentable over Privacy at Netbank (hereinafter "Netbank"; available at [www.netbank.com/security\\_privacy.htm](http://www.netbank.com/security_privacy.htm)) in view of Althoff et al. (US 2003/0018587).

Netbank discloses a method for protecting consumer personal data, comprising:  
receiving an application for a payment instrument, wherein the application comprises personal data and a privacy preference of a consumer (see generally the whole policy);

saving the application in a database (any financial institution must have the computer system with network ability and data storage);

mailing marketing material to the consumer only if permitted by the consumer's privacy preference;

wherein the privacy preference indicates that consumer receives marketing material only from affiliated merchants;

wherein the privacy preference indicates that consumer receives marketing material only from the affiliated bank; and

wherein the privacy preference indicates that the consumer opts out.

However, Netbank does not specifically disclose the step of storing the personal data and privacy preference onto the payment instrument;

wherein the payment instrument comprises a credit or debit card having a magnetic stripe, or a processor and memory; and

reading the personal data and the preference at a merchant location when the consumer's payment instrument is accessed, and saving the data at the merchant storage location.

Althoff et al. teaches, for a system and method for protecting consumer personal data, that the method comprises:

reading the personal data and the preference at a merchant location when the consumer's payment instrument is accessed, and saving the data at the merchant storage location (see Figs. 1 and 4A), wherein the payment instrument comprises a credit or debit card having a magnetic stripe, or a processor and memory (see Background and see Fig. 3).

Since Netbank and Althoff et al. are both from the same field of endeavor of protecting the consumer personal data over the financial transaction, the purpose disclosed by Althoff et al. would have been well recognized in the pertinent field of Netbank.

Accordingly, it would have been obvious at the time the invention was made to a person having ordinary skill in the art, to utilize the credit or debit card having a

Art Unit: 3629

magnetic stripe, or a processor and memory as the well known payment instrument; to read the personal data and the preference at a merchant location when the consumer's payment instrument is accessed; and to save the data at the merchant storage location, as taught by Althoff et al., for the purpose of storing and managing certain secure information and providing verified user information to merchants during the transaction to complete the "card present" transaction.

6) Claims 1 and 3, as far as they are definite, are rejected under 35 U.S.C. 103(a) as being unpatentable over Netbank in view of Pollin (US 5,727,249).

Netbank discloses the method for protecting consumer personal data as recited above, but does not specifically disclose that the payment instrument comprises a check with the privacy preference printed on.

Pollin teaches, for a system and method for protecting the consumer personal data, that the method comprises:

utilizing the check as the payment instrument; and  
storing the secure information onto the printed MICR on the check.

Since Pollin and Netbank are both from the same field of endeavor, the purpose disclosed by Pollin would have been well recognized in the pertinent field of Netbank.

Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art, to utilize the check as the well known payment

instrument, as taught by Pollin, for the purpose of storing the preference data onto the check's printed MICR as well known payment instrument.

7) Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Netbank and Althoff et al. as applied to the Claim 13 above, and further in view of Pollin.

The modified method of Netbank discloses the invention as recited earlier, but does not expressly disclose that the payment instrument comprises a check with the privacy preference printed on.

Pollin teaches, for a system and method for protecting the consumer personal data, that the method comprises:

- utilizing the check as the payment instrument; and
- storing the secure information onto the printed MICR on the check.

Since Pollin and the modified Netbank are both from the same field of endeavor, the purpose disclosed by Pollin would have been well recognized in the pertinent field of the modified Netbank.

Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art, to utilize the check as the well known payment instrument, as taught by Pollin, for the purpose of storing the preference data onto the check's printed MICR as well known payment instrument.

***Conclusion***

8) The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

JP 2002-259693 is cited to show method and system for issuing online credit card to shorten the processing time from the application procedure for online credit card issue using an information network to actual credit card issue.

US 6,493,685 is cited to show an electronic account presentation and response system and method including an information interface provider acting as the interface between a biller and its customers for both the presentment of electronic bills to the customers and for the processing of payments from the biller's customers.

US 6,032,136 is cited to show the customer activated multi-value card providing a customer with a primary use as a transaction card which can be further activated to have a secondary use as a credit card. The card allows the customer to purchase goods and services from one specific vendor and to establish a relationship with that vendor for the goods or services rendered while enjoying reward benefits based on purchases.

US 6,029,153 is cited to show a system and method for identifying and communicating the availability of additional products to at least one customer of a financial institution. A processor analyses data about the customer and identifies characteristics indicative of financial products compatible with the customer's financial needs.



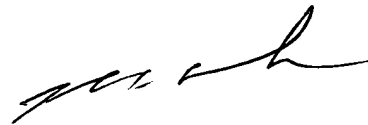
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard Woo whose telephone number is 703-308-7830. The examiner can normally be reached on Monday-Friday from 8:30 AM -5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703-308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-308-3691 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0861.



Richard Woo  
Patent Examiner  
GAU 3629  
February 24, 2003



**JOHN G. WEISS**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 3600**